

Appl. No. 10/518,883
Response Dated December 20, 2004
Reply to Office Action Mailed on March 25, 2009

REMARKS

Please reconsider this application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully reconsidering this application.

Disposition of Claims

Claims 1-4 and 6-10 are pending in this application. Claims 1 and 4 are independent. The remaining claims depend, directly or indirectly, from independent claims 1 and 4.

Claim Rejections

1, 4, and 6-9

Claims 1, 4, and 6-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admission of prior art ("APA") in view of U.S. Patent No. 5,299,359 ("Estes"), and further in view of U.S. Patent No. 4,891,115 ("Shishkin"). This rejection is respectfully traversed because there lacks motivation to combine Shishkin with Estes. Further, Estes teaches away from the combination.

Estes may not be combined with Streetman because there is no rational or reasoning to support the combination of these two references. The legal framework for determining whether there is a teaching, suggestion, or motivation to combine references used in an obviousness rejection has been called into question by the Supreme Court. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). Nonetheless, there must still be "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). "[H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claims, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

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The Court explained:

As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

[*Id.*, emphasis added]

“[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Where the examiner does not explain the “specific understanding or principle” that would motivate a person having skill to make the combination, “this court infers that the examiner selected these references with the assistance of hindsight.” *Id.* at 1357.

The Applicant respectfully submits that the Examiner has not put forth articulated reasoning or rational underpinning to support the legal conclusion of obviousness. No reason has been identified that would have prompted a person having ordinary skill in the art to combine the references, as the Supreme Court has suggested is important. Because no such reason has been set forth, the combination of Estes and Shishkin constitutes impermissible hindsight.

Further, the Applicant respectfully submits that Estes teaches away from the combination. Estes states that, in practice, “it is often necessary to measure the ovalization or corrosion of either the internal or external surfaces of these tubes to ensure that tubing which is

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about to fail is replaced.” (col. 1, ll. 26–29). Thus, Estes teaches replacing corroded pipe, and not cleaning and coating it. Therefore, Estes teaches away from the combination with Shishkin.

Claims 2 and 3

Claims 2 and 3 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Estes, and further in view of Shishkin, as applied to claim 1, and further in view of U.S. Patent No. 4,673,890 (“Copeland”). As with claim 1, the combination of Estes and Shishkin is improper, and claims 2 and 3 are allowable.

Claim 10

Claim 10 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Estes, and further in view of Shishkin, as applied to claim 4, and further in view of U.S. Patent No. 5,036,945 (“Hoyle”). As with claim 1, the combination of Estes and Shishkin is improper, and claim 10 is allowable.

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Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below.

Respectfully submitted,

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